

## **ADMINISTRATIVE PANEL DECISION**

International Business Machines Corporation v. Host Master, Transure Enterprise Ltd

Case No. D2024-4771

### **1. The Parties**

The Complainant is International Business Machines Corporation, United States of America, represented by International Business Machines Corporation (IBM), United States of America.

The Respondent is Host Master, Transure Enterprise Ltd, United States of America.

### **2. The Domain Name and Registrar**

The disputed domain name <ibm-biz.com> is registered with Above.com, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 19, 2024. On November 20, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 22, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (John Doe / above\_privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 25, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on November 25, 2024.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 19, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 8, 2024.

The Center appointed Gary Saposnik as the sole panelist in this matter on January 15, 2025. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant is a leading innovator in the design and manufacture of a wide array of products that record, process, communicate, store and retrieve information, including computers and computer hardware, software and accessories. The Complainant was incorporated in 1911 as an amalgamation of three previously existing companies and officially became International Business Machines in 1924. The Complainant has been offering products under the trademark “IBM” ever since.

The Complainant has been ranked in the top 20 most valuable global brands by leading brand publications, and in 2022 was the 49<sup>th</sup> largest company on the Fortune U.S. 500 list, and the 168<sup>th</sup> largest company on the Fortune Global 500 list.

The Complainant owns numerous trademark registrations for the mark IBM in countries around the world for a broad range of goods and services, including the following registrations in the United States, which is the location of the Respondent:

- IBM, United States Registration No. 1058803, registered February 15, 1977, in Classes 1, 2, 3, 4, 7, 9, 10, 16, 18, 37, 41 and 42;
- IBM, United States Registration No. 1205090, registered August 17, 1982, in Classes 1, 2, 7, 8, 10, 16, 37, 41 and 42;
- IBM, United States, Registration No. 4181289, registered July 31, 2012, in Classes 6, 8, 9, 11, 14, 16, 18, 20, 21, 22, 24, 25, 26, 28, 30, 35 and 41.

The Complainant’s corporate website is located at “[www.ibm.com](http://www.ibm.com)”.

The Respondent, as disclosed by the Registrar after the Complaint was filed, is a company located in Delaware. They registered the disputed domain name on July 25, 2024. The disputed domain name points visitors of the domain name to a website that creates a cybersecurity threat, resulting in a warning that says: “Suspicious Site Blocked- This site was blocked because it may contain unsafe content that can harm your device or compromise your personal info.” The Complainant sent cease-and-desist letters to the Registrar to forward to Respondent, on August 1 and August 27, 2024. No response was received by the Complainant.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant’s registered trademarks. The disputed domain name includes the letters “ibm”, followed by a hyphen “-”, the letters “biz”, and the generic Top-Level-Domain (“gTLD”) extension “.com”. The letters “ibm” contained in the disputed domain name are exactly the same as the IBM trademark. The only difference is the hyphen, highlighting the Complainant’s trademark by separating it from the rest of the domain name, and the letters “biz”, an abbreviation for the generic word “business”. The addition of the term “biz” does not prevent a finding of confusing similarity with the Complainant’s IBM mark. See *Chanel v. 1*, WIPO Case No. [D2003-0218](#); *Google Inc. v. Mr. Racha Ravinder*, WIPO Case No. [D2009-1454](#).

The Complainant avers that the Respondent has no rights or legitimate interests in the disputed domain name, as the Complainant has never licensed, contracted, or otherwise permitted anyone to apply to register the disputed domain name. Additionally, there is no evidence that “IBM” is the name of the Respondent’s corporate entity, nor is there any evidence of fair use. Furthermore, there is no evidence that the Respondent is using the disputed domain name for a bona fide offering of goods or services.

The Complainant alleges that the Respondent has been intentionally misusing the disputed domain name by pointing visitors to a website that creates a cybersecurity threat to users’ computer systems through the distribution of malware. The Respondent’s website is rendered inaccessible by Internet service providers due to its association with malware, with a security warning provided by an ISP while attempting to access the resolving website at the disputed domain name. It also appears to redirect to a different domain name, which is blocked because it has been deemed a potential security threat. Additionally, the Complainant proffers that the IP address associated with the disputed domain name is linked to anonymization services, as well as to bot command servers. The anonymization services linked to the disputed domain name conceal the Respondent’s identity, aiding in efforts to impersonate the Complainant. The botnet command and control servers linked to the disputed domain name are capable of infecting Internet users’ computers with malware.

Such unauthorized use of the IBM trademark in the disputed domain name is likely to cause consumers to erroneously believe that the Complainant is somehow affiliated with the Respondent or endorsing its commercial activities, while no relationship exists.

As to the third element of the UDRP, the Complainant asserts that the disputed domain name was registered and is being used in bad faith. There is a presumption of bad faith created solely through the “registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trade mark...” See *International Business Machines Corporation v. Jian Liu*, WIPO Case No. [D2021-0248](#); WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), Section 3.1.4. Therefore, since the disputed domain name comprises the world-famous IBM trademark in conjunction with the generic term “biz”, there is a presumption of bad faith against the Respondent.

The disputed domain name was registered many years after the registration of the Complainant’s well-known trademark, which is further proof of bad faith by the Respondent at the time of registration. As the domain name is confusingly similar to the Complainant’s mark, as well as the Respondent having no relationship to the Complainant or the IBM mark, it is considered additional evidence of opportunistic bad faith. *International Business Machines v. John Doe/Anonymize, Inc.*, WIPO Case No. [D2019-2754](#).

Additional indicia of bad faith by the Respondent is the failure to respond to the Complainant’s cease-and-desist letters, as well as using the disputed domain name for malware distribution. [WIPO Overview 3.0](#), Section 3.4. For the foregoing reasons, the Respondent has registered and is using the disputed domain name in bad faith.

## **B. Respondent**

The Respondent did not reply to the Complainant’s contentions.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant’s trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“[WIPO Overview 3.0](#)”), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the IBM mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of a hyphen “-” and the term “biz” may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

## **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. The Complainant did not authorize the Respondent’s use of the IBM trademark, the Respondent is not known by the disputed domain name, and has no legitimate noncommercial or fair use of the IBM mark.

The Complainant has presented un rebutted evidence of the Respondent misusing the disputed domain name by pointing visitors to a website that creates a cybersecurity threat to users’ computer systems through the distribution of malware. Panels have held that the use of a domain name for illegitimate activity, here, claimed as distributing malware, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

## **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent registered the disputed domain name many years after the Complainant acquired rights in its IBM mark, which has achieved well-known status through the years. There is a presumption of bad faith created solely through the “registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a

descriptive term) to a famous or widely-known trade mark...” See *International Business Machines Corporation v. Jian Liu*, WIPO Case No. [D2021-0248](#); [WIPO Overview 3.0](#), Section 3.1.4. As noted above, the disputed domain name incorporates the Complainant's famous IBM mark, with the addition of the descriptive term “biz”.

In addition to the above evidence of bad faith registration and use, paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Complainant has presented credible, un rebutted evidence of the disputed domain name being used by the Respondent to distribute various forms of malware to unsuspecting visitors to the resolving website. Panels have held that the use of a domain name for illegitimate activity, here claimed as applicable to this case, distribution of malware, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third element of the Policy.

## 7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <ibm-biz.com> be transferred to the Complainant.

/Gary Saposnik/

**Gary Saposnik**

Sole Panelist

Date: January 29, 2025